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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,251	11/19/2001	Mitsuru Nakajima	1506.1014	8391
21171	7590	09/01/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			GODDARD, BRIAN D	
			ART UNIT	PAPER NUMBER
			2171	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/988,251	Applicant(s) NAKAJIMA ET AL. 	
	Examiner Brian Goddard	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 27 May 2004.
2. Claims 1-11 are pending in this application. Claims 1-3 and 6-11 are independent claims. In Amendment A, claim 11 was added and claims 1-10 were amended. This action is made Final.

Drawings

3. The drawings were received on 27 May 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,873,080 to Coden et al. in view of U.S. Patent No. 6,230,204 to Fleming, III (Hereinafter 'Fleming').

Referring to claim 1, Coden discloses an information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for this disclosure. Coden teaches an information search system [See Fig. 1] comprising:

an information storage unit [database 150] which stores a plurality of pieces of search target information [multimedia information 151];

a searching unit [Search Engines 162-166] which searches, when a user [125] specifies a search condition [query (See Figs. 4 & 6)], for a piece of search target information [multimedia information 151] satisfying the search condition from plural pieces of search target information in the information storage unit [in database 150];

a calculating unit [Combiner 170] which calculates [See step 740] a fitting value [rank value] indicating how much the search target information satisfies the search condition about the respective pieces of search target information searched by said searching unit in accordance with a fitting value calculation procedure [ranking algorithm] specified by the user [See column 12, lines 26-35 and column 9, line 54 - column 10, line 23]; and

a result-of-search presenting unit [See column 10, lines 57-59] which presents, to the user, at least a part of information that forms each piece of search target information

searched by said searching unit [result list 380 (See step 760)] together with the fitting value [See column 10, lines 20-59 and column 12, lines 26-46] calculated by said calculating unit with respect to that piece of search target information.

Coden does not explicitly disclose the storage of personal information with respect to each of a plurality of users and information indicating that the pieces of search target information are searched by the user, nor an outputting unit which outputs...the personal information on each user by whom the piece of search target information is searched as claimed.

Fleming discloses a search and retrieval system similar to that of Coden, wherein personal information [personal information and demographic information 920] with respect to each of a plurality of users [910] and a plurality of pieces of search target information [information resource(s) or resource(s) of interest] are stored in an information storage unit [121], information indicating that the pieces of search target information are searched by the user [See Figs. 3-7 & 9] are stored in the information storage unit, and the personal information on each user by whom the piece of search target information is searched when a piece of search target information is specified is output [See Figs. 9-10] as claimed. Fleming lists a number of reasons for using this tracking information for tracking the interest of users in certain resources in the Background of the Invention section (See columns 1-2). These include monitoring loads on system resources, charging usage fees, and collecting demographic information for advertisers so they can adjust their targeting of advertisements accordingly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Fleming's personal information storage and user interest tracking functionality to the system and method of Coden to obtain the invention as claimed. One would have been motivated to do so for the reasons provided by Fleming as discussed above, in order to track the interest of users in the specific resources offered up by Coden's database.

Referring to claim 2, Coden v. Fleming discloses the information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for the details of this disclosure. Coden v. Fleming teaches "an information search system [See Fig. 1] comprising: an information storage unit [See claim 1 above]...; a calculating unit [See claim 1 above]...; an extracting unit [application of result viewing object (See step 720)] for extracting the search target information of which the fitting value calculated by said calculating unit satisfies a predetermined condition [condition(s) set by the user (See disclosure of combiner 170)], out of the plural pieces of search target information...[See claim 1 above]; a result-of-search presenting unit [See claim 1 above]...; and an outputting unit...[See claim 1 above]" as claimed.

Referring to claim 3, Coden v. Fleming discloses the information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for this disclosure. Coden v. Fleming teaches "an information search system [See Fig. 1] comprising:

an information storage unit which stores...[See claim 1 above]... search condition defining information [query specifications] for defining a search condition [query] with

respect to each of the plurality of users [users 125], and fitting value calculation procedure defining information [rank algorithm definition] for defining a procedure for calculating a fitting value [rank value] indicating how much the information searched under the search condition defined by the search condition defining information satisfies the search condition [See above];

a searching unit [See claim 1 above]... ;

a calculating unit [See claim 1 above]... ;

a result-of-search presenting unit [See claim 1 above]...; and

an outputting unit [See claim 1 above]..." as claimed.

Claim 4 is rejected on the same basis as claim 2, in light of the basis for claim 3 above. See the discussions regarding claims 1-3 for the details of this disclosure.

Referring to claim 5, Coden v. Fleming discloses the information search system as claimed. See Figures 1-7 and the corresponding portions of Coden's specification for this disclosure. Coden v. Fleming teaches the information search system according to claim 3, as above, wherein the plural pieces of search target information contain first type search target information [first media type (e.g. text)] permitted to be browsed [not restricted out by the result viewing object 350] by the one of the users, and second type search target information [second media type (e.g. image)] inhibited to be browsed [restricted out by the result viewing object 350 (See columns 9-12)] by the one of the users,

said searching unit searches for the search target information from the first type search target information contained in the plural pieces of search target information, and

said information search system further comprises... [See claim 4 above].

Claims 6 and 8 are rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Claims 7 and 9 are rejected on the same basis as claim 2. See the discussion regarding claim 2 above for the details of this disclosure.

Claim 10 is rejected on the same basis as claim 3. See the discussion regarding claim 3 above for the details of this disclosure.

Claim 11 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Response to Arguments

6. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Specifically, the remaining U.S. Patents and Patent Application Publications made of record and not relied upon are considered particularly pertinent to the amended portions of the independent claims.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg
27 August 2004



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100